REMARKS

The present application was filed on July 25, 2000 with claims 1-25. Claims 1, 24 and 25 are independent claims. In the outstanding Office Action, the Examiner: (i) rejected claims 1-4 , 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,128,633 to Michelman et al. (hereinafter "Michelman") in view of U.S. Patent No. 5,838,819 to Ruedisueli et al. (hereinafter "Ruedisueli); (ii) rejected claims 5, 10, 12 and 14 under 35 U.S.C. §103(a) as being unpatentable over Michelman in view of Ruedisueli and further in view of U.S. Patent No. 6,502,114 to Forcier (hereinafter "Forcier"); (iii) rejected claims 6, 11, 13 and 22 under 35 U.S.C. §103(a) as being unpatentable over Michelman in view of Ruedisueli and Forcier and in further view of U.S. Patent No. 5,911,146 to Johari et al. (hereinafter "Johari"); (iv) rejected claims 7-9, 20, 21 and 23 under 35 U.S.C. 103(a) as being unpatentable over Michelman in view of Ruedisueli, Forcier and Johari and in further view of U.S. Patent No. 5,909,221 to Nakai et al. (hereinafter "Nakai"); (v) rejected claims 15-17 under 35 U.S.C. 103(a) as being unpatentable over Michelman in view of Ruedisueli and in further view of U.S. Patent No. 5,454,046 to Carman, II (hereinafter "Carman"); (vi) rejected claims 16 and 18 under 35 U.S.C. 103(a) as being unpatentable over Michelman in view of Ruedisueli and Carman and in further view of U.S. Patent No. 5,576,738 to Anwyl et al. (hereinafter "Anwyl"); (vii) rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over Michelman in view of Ruedisueli and in further view of U.S. Patent No. 5,805,118 to Mishra et al. (hereinafter "Mishra").

In this response, Applicants: (i) traverse the various §103(a) rejections of claims 1-25 for at least the following reasons; (ii) amend independent claims 1, 24 and 25 to further clarify the claimed invention; and (iii) amend the specification to correct a minor typographical error.

Despite Applicants sincere belief that the claims as originally filed are patentable over the cited references, Applicants have amended independent claims 1, 24 and 25 to further clarify the claimed invention. More specifically Applicants have added the clarifying language: so as to at least partially reduce asynchrony between an electronic page and a physical page. Support for the amendment may be found throughout the present specification, for example, see page 1, line 15, through page 2, line 2; and page 2, lines 15-25. It is to be understood that such an amendment is

being made solely as a clarifying amendment in a sincere effort to move the present application to allowance.

Regarding the §103(a) rejection of independent claims 1, 24 and 25, Applicants respectfully assert that the Michelman/Ruedisueli combination fails to establish a proper case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth in M.P.E.P. §2143, three requirements must be met to establish a proper case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a proper case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, there is a clear lack of motivation to combine the references. For at least this reason, a proper case of obviousness has not been established. Michelman is directed to a method of manipulating page breaks in documents created in accordance with standard word processing and spreadsheet applications such as Microsoft Word and Excel (see columns 1 and 2 of Michelman), while Ruedisueli is directed to a method of processing electronic copies of handwritten notes. That is, the teachings in each reference are directed to completely different environments; one (Michelman) toward standard word processing and spreadsheet applications, the other (Ruedisueli) toward a handwritten note processing environment. Thus, while Ruedisueli is related to a handwriting system, Michelman has nothing to do with a handwriting system. However, other than a very general and conclusory statement in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344.

In the Office Action at page 3, the Examiner provides the following statement to prove motivation to combine Michelman and Ruedisueli, with emphasis supplied: "[i]t would have been obvious to one of ordinary skill at the time of the invention to apply Ruedisueli to Michelman, providing Michelman the benefit of adding [an] electronic notepad to the automatic page break pagination."

Applicants submit that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Michelman and Ruedisueli. For at least this reason, a proper case of obviousness has not been established. Despite the assertion in the Office Action, Applicants do not believe that Michelman and Ruedisueli are combinable since it is not clear how one would combine them. That is, how would one implement techniques relating to a handwriting system in a system that does not process handwriting. There is no guidance provided in the Office Action. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Third, Applicants assert that even if combined, the Michelman/ Ruedisueli combination fails to teach or suggest all of the limitations of the claims. For at least this reason, a proper case of obviousness has not been established.

For example, the Michelman/Ruedisueli combination fails to teach or suggest "automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page," as in the claimed invention.

For example, as the present specification explains, at page 1, line 15, through page 2, line 2:

> [In accordance with existing techniques,] . . . to maintain . . . accurate correspondence between the physical page and the electronic copy, the writer is required to "turn" the electronic page when changing to a new or previous paper page by pressing the corresponding page-forward or page-backward button on the PDN [personal digital notepad]. These buttons effect synchrony between the physical and electronic page by recording these events in the data stream. Asynchrony between the paper and electronic pages occurs when a writer forgets to press the appropriate button on the device or accidentally presses the button too many times. Subsequent writing is then electronically recorded on the wrong electronic page, and the new electronic ink is recorded on top of the page's original electronic ink. This problem may be compounded since the user may flip forward or backward by several pages at a time and may do so several times within a single document. Later, when the resultant electronic page is viewed, the merged original and overwritten electronic ink can be confusing and may be difficult to read and correct.

To address this problem, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

A key aspect with respect to the claimed invention is that the potential page breaks are automatically identified. So, even if a writer forgets to press the appropriate button on the device or accidentally presses the button too many times, causing asynchrony between the paper and electronic pages, the claimed invention automatically identifies, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page.

Michelman has nothing to do with handwriting systems and, therefore, does not address the unique electronic/physical page asynchrony problem associated with handwriting systems. However, while Ruedisueli relates to handwriting systems, it does not address the electronic/physical page asynchrony problem that the claimed invention addresses. That is, while Ruedisueli explains that

page identifiers (36) are manually entered in the upper right hand corner of a page to set the page number (column 4, lines 46-56 of Ruedisueli) and to change the page number (column 5, lines 26-40 of Ruedisueli), there is no teaching of automatically identifying, using at least a portion of the electronic ink data, one or more potential page breaks for possible insertion in the electronic document to maintain a page correspondence between the electronic document and a physical document also generated in accordance with the handwriting system, and so as to at least partially reduce asynchrony between an electronic page and a physical page, as in the claimed invention.

Thus, while Ruedisueli illustrates a user signaling a page change, the problem is that this manual signaling could be wrong, or the user could just forget to manually signal a page change, resulting in the above-described asynchrony problem. Ruedisueli provides no solutions for this problem. Also, while Michelman mentions allowing a user to select a page break via a graphical user interface and then adjusting the page breaks for the remainder of a document, again, the initial selection is still a manual process, not an automated process.

For at least these reasons, it is asserted that independent claims 1, 24 and 25 are patentable over Michelman and Ruedisueli.

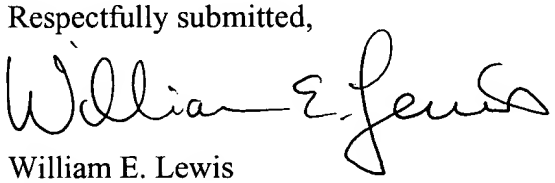
Regarding the §103(a) rejection of dependent claims 2-23, Applicants respectfully assert that the various combinations, based on Michelman/Ruedisueli that also include one or more of Forcier, Johari, Nakai, Carman, Anwyl and Mishra, also fail to establish proper cases of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143. Such dependent claims are patentable over the cited combinations not only due to their dependence on independent claim 1 but also because such claims recite patentable subject matter in their own right.

It is to be noted that many of the dependent claims recite specific implementations of the automated page break identification step of the claimed invention. First, the very fact that the Office Action attempts to employ Forcier, Johari, Nakai, Carman, Anwyl and Mishra is further evidence that the base combination of Michelman and Ruedisueli fails to teach or suggest the automated page break identification step of the claimed invention. However, Applicants also assert that Forcier, Johari, Nakai, Carman, Anwyl and Mishra (both the cited portions and the references in their entirety) fail to teach or suggest all of the detailed features recited in dependent claims 2-23.

That is, by way of example, despite assertions to the contrary in the Office Action, Forcier, Johari, Nakai, Carman, Anwyl and/or Mishra do not teach or suggest the spatial difference method of claims 5, the constrained region method of claim 10, the field appropriateness of claim 12, or the overlap method of claim 14. Further, by way of example, despite assertions to the contrary in the Office Action, Forcier, Johari, Nakai, Carman, Anwyl and/or Mishra fail to teach or suggest the moving average method of claims 15 and 17, or the score combination method of claim 20.

In view of the above, Applicants believe that claims 1-25 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,



Date: January 12, 2004

William E. Lewis
Attorney for Applicant(s)
Reg. No. 39,274
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-2946